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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,810	05/31/2000	Dimitri Kanevsky	13539(YOR9-2000-0196US1)	2276

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EXAMINER

BOUTAH, ALINA A

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/584,810

Applicant(s)

KANEVSKY ET AL.

Examiner

Alina N Boutah

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2143

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment received June 30, 2004. Claims 18 and 19 have been newly added. Claims 1-5, and 7-19 are pending in the present application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 26, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 8, 9, 11-13 and 15-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Probert.

Art Unit: 2143

Regarding claim 1, Shaffer et al. teach a method for re-formatting computer files, comprising the steps:

inputting a data file into a computer (Abstract);

using said computer to determine if the data file is compatible with the computer or applications which exist on the computer (Abstract; col. 2, lines 31-34);

if the data file is not compatible with the computer, transmitting the data file over the Internet from said computer to a universal server (Abstract; col. 3, lines 4-6, lines 21-37); and

the universal server, transforming the data file into a format compatible with the computer, and sending the transformed data file back to the computer (figure 1; col. 3, lines 21-37; col. 5, lines 22-42).

However, Shaffer fails to teach inputting a data file into a computer having a specified operating system; using said computer to determine if the data file is compatible with the specified operating system; and the universal server transforming the data file into a format compatible with the specified operating system of the computer.

Probert teaches these limitations in (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Regarding claim 2, Shaffer et al. teach a method according to Claim 1, wherein the transforming step includes the steps of, the universal server identifying the type of file, and transforming the file into a different format of the same type (col. 1, line 55 – col. 2, line 3).

Regarding claim 4, Shaffer et al. teach a method according to claim 1, wherein, when data needs to be converted, the data are sent to a universal conversion server; the universal conversion server finds that the service cannot convert a certain file, the service looks in a computer description; the computer description can be located on the computer or on a universal conversion server database (col. 3, lines 1-13).

Regarding claim 5, Shaffer et al. fail to teach a method according to claim 1, wherein when a computer's operating system is not compatible with a program, the program is sent to a Universal Driver where the program is to be formatted; when being formatted, the program is looked over to identify components of the program including links to the program source code, the program's executable code, the program's file name; entering data to a database of source codes, where many source codes are held; and if the same name exists among more than one program in to database, the Universal Server reads the information from the description module (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Art Unit: 2143

Regarding claim 8, this is similar to claim 1 therefore is rejected under the same rationale as specified above.

Regarding claim 9, this is similar to claim 2 therefore is rejected under the same rationale as specified above.

Regarding claim 11, this is similar to claim 4 therefore is rejected under the same rationale as specified above.

Regarding claim 12, this is similar to claim 1 therefore is rejected under the same rationale as specified above.

Regarding claim 13, this is similar to claim 2 therefore is rejected under the same rationale as specified above.

Regarding claim 15, this is similar to claim 4 therefore is rejected under the same rationale as specified above.

Regarding claim 16, this is similar to claim 5 therefore is rejected under the same rationale as specified above.

Art Unit: 2143

Regarding claim 17, Shaffer et al. teach a method according to claim 1, further comprising the step of providing the Universal Server with access to a module having a series of source codes, and wherein the step of formatting the data file into a format compatible with the operating system of the computer modules the steps of:

the Universal Server obtaining from said module the source code for the data file (figure 1; col. 3, lines 21-37; col. 5, lines 22-42).

However, Shaffer does not teach the Universal Server recompiling the data file, using the source code obtained from said module, into the format compatible with the operating system of the computer. Probert teaches these limitations in (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

(New) Regarding claim 18, Shaffer fails to explicitly teach a method according to Claim 17, wherein the step of the Universal Server recompiling the data file includes the steps of the Universal Server using the source code obtained from said module to modify the source code of the data file and using a compiler to compile a new data file, compatible with computer, from the modified source code of the data file. Probert teaches using the source code obtained from said module to modify the source code of the data file (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50); and using a compiler to compile a new data file, compatible with computer,

Art Unit: 2143

from the modified source code of the data file (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

(New) Regarding claim 19, Shaffer fails to teach a method according to Claim 18, further comprising the step of the Universal Server reading from the computer the type of operating system on the computer. Probert teaches a universal server reading from the computer the type of operating system on the computer (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Claims 3, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. in view of CERN Conversion Service.

Regarding claim 3, Shaffer et al. fails to teach a method according to claim 1, further comprising the steps of: a user of the computer identifying user requirements; and transmitting the user requirements to the universal server; and wherein the transforming step includes the step of re-formatting the file in accordance with the user requirements.

Art Unit: 2143

CERN teaches a method for re-formatting a computer file comprising steps of: a user of the computer identifying user requirements; and transmitting the user requirements to the universal server; and wherein the transforming step includes the step of re-formatting the file in accordance with the user requirements (CERN User Guide, page 1-4). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of CERN into the teaching of Shaffer et al. allow the file conversion to be performed according to the user's need.

Regarding claim 10, this is similar to claim 3 therefore is rejected under the same rationale as specified above.

Regarding claim 14, this is similar to claim 3 therefore is rejected under the same rationale as specified above.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,549,918 issued to Probert, Jr. et al in view of CERN.

Regarding claim 7, Probert Jr. et al. teach a universal program conversion method, comprising the steps of:

entering data into a computer (col. 1, line 60 – col. 2, line 19);

Art Unit: 2143

said computer having a specified operating system and checking to determine whether the format is compatible with an operating system (OS) in the computer (col. 1, line 60 to col. 2, line 19; col. 3, line 13 to col. 4, line 57);

if the format is not compatible, sending the data from the computer over a network to a remote Universal Driver (col. 3, line 13 to col. 4, line 57);

on the Universal Driver, reformatting the data into a format compatible to the OS (col. 3, line 13 to col. 4, line 57);

if it is determined that the data are compatible with the operating system, then checking to determine whether it is necessary to reformat the data (col. 3, line 13 to col. 4, line 57);

if the data do not need to be reformatted, processing the data as the user requests; and

otherwise, sending the data to the universal server; and this server checking whether the data are executables; if the data are executables, then checking the Universal Driver to determine whether the data can be formatted on the Universal Driver; if the data can be so formatted, then formatting the data at the Universal Driver; and then sending the formatted data to the user; if the data can not be formatted at the Universal Driver, then checking to determine if the source code exists on a storage of source code; if the source code exists, then recompiling the data in a new OS, and then sending the data to the user; checking for instructions to format data; after the checking step, formatting the data are formatted according to the instructions, and then sending the data to the user (Abstract; col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50).

However, Probert, Jr. et al. fail to teach sending the data to a universal formatting server after the reformatting step to be converted to the format suitable for the user. CERN teaches sending data to a universal formatting server for converting data suitable for the user (CERN

Art Unit: 2143

User Guide, page 1-4). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of CERN into the teaching of Probert et al. in order allow the file conversion to be performed according to the user's need.

Response to Arguments

Applicant's arguments with respect to claim 1 has been considered but is not persuasive. Applicant argues that the prior art of record does not disclose or suggest the feature of, when the computer determines that a data file is not compatible with the computer's operating system, sending the data file over the internet from the computer to a remote server to convert the file to a format that is compatible with the computer's operating system. The Patent Office respectfully disagrees. As specified above, the combination of Shaffer and Probert teaches this limitation. Specifically, Abstract; col. 3, lines 4-6, lines 21-37 of Shaffer teaches sending the data file from the computer to a remote server to convert the file format that is compatible with the computer, and col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50 of Probert teaches converting the file format that is compatible with the computer's operating system.

For the reasons above, the rejection of independent claims, as well as dependent claims are sustained.

Art Unit: 2143

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N Boutah whose telephone number is (703) 305-5104. The examiner can normally be reached on Monday-Thursday (9:00 am-7:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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